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Remarks

Reconsideration of the application is respectfully requested. Claims 1, 2, 4-8, 11-12 and 13-16 remain pending. In view of the Office Action having been made final, no amendments to the claims are tendered since amendments of the claims are not normally entered or considered at this stage.

Claim Objection:

Claim 2 was objected to for informalities, i.e. "not written in completed form". Applicant is unable to address this objection. Dependent claim 2 references independent claim 1 and forms a sentence having limitations that are to be construed in conjunction with claim 1. Thus claim 2 is in compliance with 35 U.S.C. 112, second paragraph and is in a "complete form". If an objection to claim 2 is maintained, a more detailed explanation of the nature of the objection is requested.

Claim Rejections 35 U.S.C. 103:

Claims 1, 2, 4-6, 13 and 14 were rejected under 35 U.S.C. 103 as being unpatentable over Jiang (US-2004/0120494) in view of Larsen (US-2004/0151292). Applicant respectfully traverses this rejection for reasons explained below.

Claim 1 is directed to an automated method for correlating data associated with separate call detail records. Those of ordinary skill in the art will understand that a call detail record (CDR) is a specific type of record generated and stored in telecommunication infrastructure equipment upon a call origination and/or termination and is utilized to determine customer billing by the telecommunication provider. Typically, call detail records are stored in a database of the telecommunication provider and are eventually processed to obtain billing information utilized for generating monthly customer bills.

Jiang is directed to a method for supplying selectable, customized ring back tones. As explained in Jiang at paragraphs 16-30, an IP 116 stores, or has access to another element that stores, custom ring tones that can be selected by the called party. For example, a favorite song of the called party could be selected to be played to the calling party while the telephone of the called party rings. This permits custom audio information to be played instead of conventional ring back tones to the calling party while the telephone of the called party rings.

The process as taught in Jiang dealing with selectable ring back tones/audio has nothing to do with the generation or use of call detail records. One step of claim 1 recites accessing a first call detail record associated with one of the calling and called parties for a first previously completed call. Jiang does not teach or suggest accessing of a call detail record.

Further, the process as explained in Jiang relates to the selection of audio information to be played during a ring back time interval involved in the attempted completion of a call. As defined in the first paragraph of the body of claim 1, the accessing of the call detail record occurs for a first previously completed call. Jiang teaches away from the requirement of the present invention as defined in claim 1 in that the discussed processing in Jiang must occur **prior to a call completion** to the called party, and hence Jiang could not derive information needed from a call detail record (the corresponding call detail record for such a call would not be in existence at the time the ring tone audio information is needed in Jiang).

In accordance with claim 1, the identity of the other of the calling and called parties is ascertained from the first call detail record associated with the previously completed call. Since the call detail record is defined in claim 1 as associated with a first previously completed call, it will be apparent to those of ordinary skill the art that it would be impossible for Jiang to ascertain the identity of one of the parties from a call detail record in order to determine the audio to be played during the ring tone time interval since a call detail record of a completed call is inherently not available prior to the completion of the call.

Larsen is cited for disclosing call detail records for previously completed calls. Call detail records are not *per se* new. That is, call detail records have been utilized for conventional billing practices.

A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). It is well-settled that teachings of a reference that teach away from a limitation of the claimed invention must be considered as well as teachings of the reference that could point towards the invention.

...an applicant may rebut a prima facie case of obviousness by showing that the prior art teaches away from the claimed invention in any material respect. *In re Geisler*, 116 F.3d at 1469, 43 USPQ2d at 1365 (quoting *In re Malagari*, 499 F.2d at 1303, 182 USPQ at 553). *In re Peterson*, 315 F.3d 1325, 65 USPQ2d 1379 (CA FC 2003)

Jiang teaches away from the present invention defined by claim 1 in a material respect in that the basic objective of Jiang requires that information be available prior to call completion for use in determining the ring back audio is to be used. It is apparent that this required information could not be obtained from a corresponding call detail record since the latter is not in existence at the required time needed in Jiang.

Even if Larsen is considered in combination with Jiang, such a combination does not solve the inherent problem that a call detail record is simply not suitable for obtaining the information needed by Jiang.

Modifying Jiang to use the call detail record as disclosed in Larsen would change the principle of operation of Jiang. This is apparent since Jiang could no longer operate in the method disclosed in it if the ring tone information needed by Jiang were to be attempted to be derived from a call detail record. In fact, it is not seen how Jiang to perform the intended functions of ring tone determination based on a call detail record of a corresponding call which would not yet be available.

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)

In the Office Action on page 4 it was alleged to

"have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Jiang as taught by Larsen for purpose of keeping the user information updated in order for the system processing the future call faster."

Applicant respectfully disagrees with this assertion. It will be remembered that Larsen is directed to a system involving permitting users to utilize prepaid and postpaid telephony services, and that Jiang is directed to a telephony system that permits users to select audio to be played to a calling party during the normal ring back time interval. Even if one of ordinary skill in the art would consider combining the teachings of Larsen into Jiang (which is not believed to be likely), the alleged result, i.e. motivation for combining the teaching of these two references, of achieving the processing of future calls faster by keeping user information updated would not be achieved. At the time of processing a call request, whatever user information is required to complete this request will be accessed as it exists at that time. Even if other or newer user information was stored at another location in the telecommunication system, it would not affect the speed of call completion because it would not be considered at the time of the requested call. Therefore, the alleged motivation for the combination of the teachings of these two references is not present. Since the reason for the alleged combination is the shown not to be present, a prima facie motivation for combining the teachings of these two references under 35 U.S.C. 103 has not been made. Thus, the rejection based on this combination should be withdrawn.

The relied upon combination of Jiang and Larsen do not provide a prima facie ground for rejection of claim 1 for the reasons discussed above. The withdrawal of this rejection of claim 1 is requested.

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Claims 8, 11, 12, 15 and 16 were rejected under 35 U.S.C. 103 as being unpatentable over Elliott (US 5,768,352) in view of Jiang and Larsen. Applicant respectfully traverses this rejection.

Although Elliott is relied upon as disclosing certain features identified on page 8 of the Office Action, it is acknowledged on pages 8-9 that Elliott does not disclose all of the limitations contained in claim 8. Jiang in combination with Larsen is relied upon to supply the substantial missing details acknowledged as not disclosed by Elliott. The combination of Jiang and Larsen is relied upon in a substantially identical manner as utilized in forming the basis for the rejection of claim 1. Because the combination of Jiang and Larsen fail to provide a prima facie ground for support of the required teachings for which they are relied upon in claim 8 in a similar manner to their failure as explained above with regard to claim 1, the rejection of claim 8 based on the combination of the applied references should be withdrawn.

Claims 13 and 15 further define the methods defined in claims 1 and 8, respectively. Each contains a similar limitation in which a first call detail record is modified to indicate that the other party subscribed to the predetermined feature if it is determined that the predetermined correlation exists for the first call based on whether the one party subscribes to the first feature and the other party subscribes to the predetermined feature. This teaching is allegedly taught by Larsen at paragraphs 43-49. This rejection is respectfully traversed since a reading of the subject paragraphs in Larsen has failed to disclose the recited subject matter or its equivalent. If this rejection is to be maintained, it is respectfully requested that the Examiner specifically point out the language in these paragraphs that is believed to provide such a teaching.

Therefore, it is believed that none of the applied references, considered individually or in combination, render the subject matter of claims 1 or 8 obvious.

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In view of the above amendments and remarks, allowance of all claims pending is respectfully requested. If a telephone conference would be of assistance in advancing the prosecution of this application, the Examiner is invited to call applicants' attorney.

Respectfully submitted,



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